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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,050	01/25/2006	Ji-Hyun Kim	Q90861	8300

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EXAMINER	
VAKILI, ZOHREH	

ART UNIT	PAPER NUMBER
1614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/554,050	KIM ET AL.	
	Examiner	Art Unit	
	ZOHREH VAKILI	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) *1-5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-6 are presented for examination.

Applicant's Amendment filed December 19, 2007 has been received and entered into the present application. Claims 1-5 are withdrawn. Claim 6 is pending and is herein examined on the merits.

Applicant's arguments, filed December 19, 2007 have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Response to Declaration under C.F.R. §1.132

Applicant's Declaration of Jihyun Kim submitted under 37 C.F.R. 1.132 filed October 18, 2007 have been received and entered into the application.

In view of the amendments and remarks made herein, the rejection of claim 6 under 35 U.S.C 102(b) have been hereby **withdrawn.**

Applicant's Declarations have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103 (New Grounds of Rejection)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: 1. Determining the scope and contents of the prior art. 2. Ascertaining the differences between the prior art and the claims at issue. 3.Resolving the level of ordinary skill in the pertinent art. 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spiegel (US Pub. No. 20040082657) and in view of Park et al. (US Pub. No. 2005/0130912 A1).

Spiegel teaches the present invention is a method and composition for suppressing the appetite of a human being using L-theanine. The method comprises the step of orally administering a composition comprising an appetite-suppressing amount of L-theanine. The L-theanine composition used as an appetite suppressant in accordance with the invention can be provided in solid form or liquid form and can be further combined with one or more inert ingredients or one or more additional active ingredients. The appetite suppressant composition of the invention provides a natural way of suppressing the appetite of a human being without causing the side effects associated with conventional appetite suppressants (see abstract). the L-theanine and D-theanine can be included together in the appetite suppressant composition. The L-theanine used in the composition of the invention can be used in a pure form (at least 99% L-theanine), in more crude forms including 50% or more L-theanine, or can be present as a tea extract (see paragraph 0009). [0015] With respect to the additional active ingredients, Exemplary fat metabolizers include chromium picolinate, L-cysteine and L-carnitine.

The method according to claim 1, wherein the administering step comprises

orally administering a composition comprising L-theanine and at least one additional appetite suppressant (see claim 9). The method according to claim 9, wherein the additional appetite suppressant is selected from the group consisting of caffeine, ephedrine, phenylpropanolamine (PPA), L-glutamine, L-glutamic acid and mazindol (see claim 10).

Park et al. teach the composition of the present invention which comprises genistein 0.001 about 30 wt % to the total weight of the composition (see paragraph 0019). The composition of the present invention also comprises L-camitine 0.001.about.50 wt % to the total weight of the composition (see paragraph 0023). Park et al. further teach in the present invention a composition comprising genistein and L-carnitine for treating obesity, which accelerates the oxidation of fat in a fat cell and can be administered orally (see paragraph 0024)

Clearly, the skilled artisan is provided with ample instruction and motivation to use theanine, genisteine, L-carnitine, and caffeine to produce a composition that has slimming effect. The skilled artisan is motivated to make compositions of the well known ingredients for medicinal and cosmetic uses, most notably for their anti-suppressant properties to offset the losing of weight by those who are in need of such a composition. The prior arts teache of the same component and its concentration that is instantly claimed. Accordingly, it is well settled that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the

properties applicant discloses and/or claims are necessarily present. In other words, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. See In reBest, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Applicant's amendments and remarks have been carefully considered in their entirety, but fail to be persuasive in establishing error in the propriety of the present rejection.

Conclusion

No claims of the present application are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Vakili whose telephone number is 571-272-3099. The examiner can normally be reached on 8:30-5:00 Mon.-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Zohreh Vakili

Patent Examiner May 30, 2008

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/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614